



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,372	03/04/2002	Eric M. Ferreira	1950-0001	7247

23980 7590 03/25/2004

REED & EBERLE LLP  
800 MENLO AVENUE, SUITE 210  
MENLO PARK, CA 94025

EXAMINER

SHIPPEN, MICHAEL L

ART UNIT PAPER NUMBER

1621

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/091,372

Applicant(s)

FERREIRA ET AL.

Examiner

MICHAEL L. SHIPPEN

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 18-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/11/02; 9/11/02; 12/10/02
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 20040204
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

Claims 25-42 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed December 11, 2003. Claims 18-24 also stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as not reading upon the elected species, there being no allowable generic claim.

***Claim Rejections - 35 USC § 112<sup>1</sup>***

Claims 1-17 are rejected under 35 USC 112, first and second paragraphs. The claims fail to set adequately set forth critical elements of the claimed invention. There is not an adequate indication of the reactants, products, reagents and reaction conditions contemplated. Moreover, the specification acknowledges that some of these elements are in fact critical which is not pointed out in the claims. For example, in Table I, it is apparent that only a specific group of chiral ligands are operable in the claimed process since, of the 6 chiral ligands tested, only 2 afforded enantiomeric excess. Just below Table 1, applicants state that the palladium source is critical. As such it would appear

---

<sup>1</sup> The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1621

that not all metal sources or chiral ligands embraced by the claim language would be suitable. If the claims are intended to read on still other ligands and metal sources, the specification does not adequately teach one how to practice the claimed invention since there is no indication of how one would make such processes operable.

***Claim Rejections - 35 USC § 102<sup>2</sup>***

Claims 1, 2, 5 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,184,381. See Examples 79-93.

Claims 1-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hosokawa (J. Am. Chem. Soc., Vol. 103, pp. 2318-2323 (1981)). See the examples and tables.

***Claim Rejections - 35 USC § 103<sup>3</sup>***

Claims 1, 2, 5, 6 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,184,381. The reference is applied as above. In addition to

---

<sup>2</sup> The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

<sup>3</sup> The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1621

the specific examples the reference teaches that other process parameters may be varied, note columns 25 to the top of column 28 and Example C. It is well within the skill of the artisan to operate within the parameters taught in the art to obtain the results taught in the art. To the extent the claims read on reactants not exemplified by the reference, the claims read on reactants that are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious.

Claims 1-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosokawa (J. Am. Chem. Soc., Vol. 103, pp. 2318-2323 (1981)). The reference is applied as above. In addition to the specific examples the reference teaches, it is well within the skill of the artisan to vary the parameters taught in the art with the expectation of obtaining similar results taught in the art. To the extent the claims read on reactants not exemplified by the reference, the claims read on reactants that are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would


Art Unit: 1621

expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious.

Claims 1, 2 and 5-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,350,916. The reference generically teaches the claimed process, note the last full paragraph of column 15 to the top of column 16 and claims 18+. It is well within the skill of the artisan to operate within the parameters taught in the art to obtain the results taught in the art. To the extent the claims read on reactants not exemplified by the reference, the claims read on reactants that are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **703-872-9306**.

MShippen  
March 22, 2004

  
**MICHAEL L. SHIPPEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1621**